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Masahiro Oho

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EXAMINER

QAYYUM, ZESHAN

ART UNIT

PAPER NUMBER

3685

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                   |  |
|------------------------------|--------------------------------------|-----------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/587,432 | <b>Applicant(s)</b><br>OHO ET AL. |  |
|                              | <b>Examiner</b><br>ZESHAN QAYYUM     | <b>Art Unit</b><br>3685           |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4-7 and 9-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-7, 9-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### **Status of Claims**

1. Claims 1, 4-7, 9-25 have been examined.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.
3. Applicant is of the opinion that Ginter fail to teach "a content key which is decrypting the encrypted content inserted into the generated license information only when the usage condition is within a range designated in edit condition information; when the license information is received by a terminal device, the terminal device decrypts the content using the content key included in the license information only when the usage condition is judged to be within the range" The Examiner respectfully disagrees. Ginter discloses a content key which is decrypting the encrypted content inserted into the generated license (i.e. PERC) information only when the usage condition is within a range designated in edit condition information; when the license information is received by a terminal device, the terminal device decrypts the content using the content key included in the license information only when the usage condition is judged to be within the range (See column 19, lines 9-58, column 30, lines 29-40, Fig 79, column 155, lines 38-67, column 156 lines 1-10 and column 281, lines 23-26).
4. With respect to "When clause" conditional languages do not narrow the claims because they can be omitted. According to MPEP "Language that suggests or

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makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation" (MPEP §2106 II. C).

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-7, 9-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
6. Claim 1 is directed to a right management system. Claim recites a content provider and a service provider, which is not statutory. Notice; "if the broadest reasonable interpretation of the claimed invention as a whole encompasses a human being, then a rejection under 35 U.S.C. 101 must be made indicating that the claimed invention is directed to nonstatutory subject matter" (see MPEP section 2105).
7. Claims 2-6 are also rejected as each depends from claim 1.
8. Claim 7 and 19 are directed to a right management device and a terminal device respectively. Specifically, Claims recite a license information generation unit, a range designation unit, a content key obtainment unit, a usage condition judgment unit, validation unit, a request unit, a license information obtainment unit and an abandon unit. However, this is merely software, and it has been held that software without a required computer-readable medium-storing software

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that, when executed, causes the computer to perform a particular process or method (MPEP 2106.01) is merely nonfunctional descriptive material and non-statutory under 35 U.S.C. 101.

9. Claims 9-18 are also rejected as each depends from claim 7.

10. With respect to claim 20-21, Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

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In this particular case, claims 20-21 fail prong (1) because the "tie" (e.g. obtaining in the device) is representative of extra-solution activity. Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1, 4-7 and 9-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downs (US 6226618) in view of Ginter (US 5892900).
12. With respect to claims 1, 7, 9, 10-12 and 19-25 Down discloses: a content provider that produces the content, said content provider including a first right management device (See column 9, lines 5-60); a service provider that issues the license information to an end user, said service provider including a second right management device (See column 10, lines 50-67); a terminal device for the end user to use the content (See column 11, lines 30-54), wherein said first right management device encrypts the produced content using a content key, and provides the encrypted content to said terminal device (See column 9, lines 5-60), wherein said second right management device comprises a license

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information generation unit configured to generate the license information to include a usage condition for allowing usage of the content; a transmission unit operable configured to transmit the generated license information to said terminal device (See column 10, lines 50-67); a second range designation obtainment unit; a second usage condition judgment unit; and a second validation unit; wherein said second range designation obtainment unit is configured to obtain edit condition information generated by said first right management device that indicates a range designation of the usage condition, said second usage condition judgment unit is configured to judge whether or not the usage condition is within the range designated in the edit condition information, and said second validation unit is configured to insert the content key, which is a key for decrypting the encrypted content, into the generated license information only when the usage condition is within the range (See column 10, lines 50-67, column 18, lines 11-67 and column 19, lines 1-35) wherein said terminal device comprises: a reception unit configured to receive the license information from said second right management device (See column 10, lines 50-67).

Down does not explicitly disclose: a range designation obtainment unit configured to obtain the edit condition information generated by said first right management device that indicates the range designation of the usage condition included in the license information; a usage condition judgment unit configured to judge whether or not the usage condition included in the license information received from said second right management device is within the range

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designated in the obtained edit condition information; and a validation unit configured to validate the received license information and decrypt the content using the content key included in the license information only when the usage condition is judged to be within the range, and abandon the received license information when the usage condition is judged not to be within the range. Ginter discloses: a range designation obtainment unit configured to obtain the edit condition information generated by said first right management device that indicates the range designation of the usage condition included in the license information; a usage condition judgment unit configured to judge whether or not the usage condition included in the license information received from said second right management device is within the range designated in the obtained edit condition information; and a validation unit configured to validate the received license information and decrypt the content using the content key included in the license information only when the usage condition is judged to be within the range, and abandon the received license information when the usage condition is judged not to be within the range (See column 19, lines 9-58, column 30, lines 29-40, Fig 79, and column 281 lines 23-26) Therefore, it would have been obvious to one of the ordinary skill in the art at the time invention was made to modify Down with Ginter reference in order to provide extra security for content distribution.

*In addition* with respect to "when clause", according to MPEP "Language that suggests or makes optional but does not require steps to be performed or does



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not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. (MPEP 2106 II C)" therefore the language "when" will not distinct the claims from prior art.

13. With respect to claims 4, 5, and 6, 13, 14, 15, 16, 17, 18, Downs in view of Ginter discloses all the limitations as described above. Ginter further discloses: said first right management device comprises a contract license (i.e. PERC) generation unit operable to generate contract license information including the content key and the edit condition information and, a transmission unit operable to transmit the generated contract license to said second right management device; and said second right management device further comprises a contract license reception unit operable to receive the contract license from said first right management device; said second range designation obtainment unit is operable to obtain the edit condition information from the received contract license; said second usage condition judgment unit is operable to judge whether or not the usage condition included in the generated license information is within the range shown in the obtained edit condition information; and said second validation unit is operable to extract the content key from the received contract license and to insert the extracted content key into the generated license information only when the usage condition is within the range. See column 19, lines 9-58, column 30, lines 29-40, Fig 79, column 155, lines 38-67, column 156 lines 1-10, and column 281, lines 23-26 ).

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*In addition* with respect to "when clause", according to MPEP "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. (MPEP 2106 II C)" therefore the language "when" will not distinct the claims from prior art.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ZESHAN QAYYUM whose telephone number is (571)270-3323. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L. Hewitt can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Z. Q./

Examiner, Art Unit 3685

/Calvin L Hewitt II/

Supervisory Patent Examiner, Art Unit 3685